

REMARKS

Formal Matters

Claims 1-10 and 14-24 are all the claims pending in the present Application. By this amendment, Applicant adds new claim 24 in order to describe the invention more particularly. Ample support for the newly added claim may be found throughout the specification. Applicant also cancels claims 12 and 13 without prejudice or disclaimer.

Applicant thanks the Examiner for acknowledging the receipt of priority documents submitted under 35 U.S.C. § 119, initialing the information disclosure statement (IDS) submitted on January 3, 2007, and accepting the drawings filed on November 13, 2003.

Double Patenting

Claim 12 stands objected to by the Examiner under 37 C.F.R. § 1.75 as allegedly being a substantial duplicate of claim 7. Claim 13 is objected to by the Examiner under 37 C.F.R. § 1.75 as allegedly being a substantial duplicate of claim 8. Claims 12 and 13 are canceled, thereby rendering the objections moot. Accordingly, Applicant respectfully requests that the Examiner withdraw the objections.

Claim Rejections Under 35 U.S.C. § 103

Anderson '205 in view of Official Notice

Claims 1, 4 and 5 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,778,205 to Anderson et al. ("Anderson '205") in view of Official Notice. Applicant traverses this rejection for at least the following reasons.

The Examiner purports to take Official Notice that adhering labeling layers to a storage medium by lamination was conventional in the art at the time of invention. However, the Examiner does not provide any support or evidence for this assertion.

The MPEP clearly states that “[i]t would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.” MPEP § 2144.03[A] (8th ed. Rev. 6, Aug. 2006) (emphasis in original). Applicant respectfully submits that in the context of the cited references, the Examiner’s assertion is incorrect, and is not “capable of instant and unquestionable demonstration.”

Furthermore, when an assertion of Official Notice is traversed, the Examiner is required to provide the reasoning and evidence in support of any such assertions. MPEP § 2144.03[C]. Since the Examiner, in this instance, fails to provide any such evidence, the assertion of Official Notice fails to support a prima facie case of obviousness.

Thus, Anderson ‘205, in combination with the Examiner’s assertions regarding Official Notice, fails to set forth a prima facie case of obviousness. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 1 and its dependent claims 4 and 5.

Claim 1 further discusses that at least a portion of the indication information is rewritable. The Examiner cites a phase contrast layer to teach this aspect of the invention. Applicant submits that phase contrast involves a change in physical characteristics which are not necessarily rewritable. Therefore, Applicant submits that the rewritability is not inherently suggested in the art.

Anderson ‘205 in view of Official Notice, in further view of Nakano

Claim 2 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Anderson ‘205 in view of the Examiner’s purported Official Notice, and further in view of U.S.

Patent Publication No. 2001/0008872 to Nakano (“Nakano”). Applicant traverses this rejection for at least the following reasons.

Claim 2 depends from independent claim 1. The deficiencies of the Examiner’s assertion of Official Notice with respect to claim 1 are set forth above. Nakano, moreover, fails to make up for the above described deficiencies of the Examiner’s assertion of Official Notice, as Nakano is cited merely for its alleged teaching of an indication layer including electronic paper. Thus, Anderson ‘205, the Examiner’s Official Notice, and Nakano, alone or in combination, fail to render claim 2 unpatentable. Accordingly, Applicant respectfully requests that the Examiner withdraw this rejection.

In addition, the Examiner’s suggestion for combining the references is to allow a visible indication. However, Anderson already provides a visible indication via thermal changes in a dye. (Anderson at col. 3, lines 62-64.) Therefore, the Examiner’s proffered reason for the combination is not supportable.

Anderson ‘205 in view of Araki

Claims 3, 22 and 23 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Anderson ‘205 in view of U.S. Patent Publication No. 2003/0103762 to Araki et al. (“Araki”). Applicant traverses this rejection for at least the following reasons.

Claim 3 requires that “the indication layer has a cholesteric layer and a transparent electrode layer on a light absorbing layer.” Although the Examiner concedes that Anderson ‘205 fails to disclose this element of claim 3, the Examiner cites Araki at ¶ [0106] as allegedly teaching this element of claim 3. As a purported motivation to combine these references, the Examiner states only that a motivation is “to provide a visible image on the recording medium.”

This purported motivation is insufficient to lead one of ordinary skill in the art to combine these references. Firstly, Anderson '205 appears to be capable of providing a "visible image" on the laser writable label side of the optical data storage disk without the addition of any further references, such as Araki. Secondly, the purported combination of Anderson '205 in view of Araki would require extensive untaught modifications in order to arrive at the invention of claim 3.

Since neither Anderson '205 nor Araki appear to contemplate the combination of a cholesteric layer and a transparent electrode with a storage medium such as that of Anderson '205, "a substantial reconstruction and redesign of the elements shown in [the primary reference]" would be required in order to reach the invention claimed in claim 3. MPEP § 2143.01[IV] (internal quotations omitted). For example, Fig. 1 of Araki shows a medium connection section 11 connected to a plurality of image record media 14. Nothing in Araki or Anderson '205 teaches or suggests, for example, how the medium connection section 11 should be modified in order to be combined with the recording medium of Anderson '205. Thus, it is clear that extensive modification of Araki and Anderson '205 would be required in order to reach the medium of claim 3. Furthermore, it is not clear that one of ordinary skill in the art would be successful in making such a combination.

Thus, the Examiner's purported motivation to combine Anderson '205 in view of Araki fails to provide a prima facie case of obviousness with respect to claim 3. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 3 and its dependent claims 22 and 23.

Anderson '205 in view of Anderson '586

Claims 6, 7, 9, 10, 12, 14-19 and 21 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Anderson '205 in view of U.S. Patent No. 7,145,586 to Anderson et al. ("Anderson '586"). Applicant traverses this rejection for at least the following reasons.

Independent claim 6 requires "a detecting section detecting a difference between storage data which is stored at the storage layer of the recording medium, and new data which is to be subsequently stored." The Examiner concedes that Anderson '205 fails to disclose this element of claim 6. The Examiner contends, however, that Anderson '586 does disclose this element, citing only Fig. 6 of Anderson '586.

Fig. 6 of Anderson '586 shows a step 602, labeled "determine information based on data side of optical disk," and a step 608 labeled "determine information based on data side of optical disk." Applicant respectfully points out that neither step 602, nor step 608, describe "detecting a difference between storage data . . . and new data."

Furthermore, the related description at col. 7, lines 49-63 of Anderson '586, state as follows:

If the list of files or the space used or remaining on the data side of the optical disc changes, or if the user requests that the marking be updated, then the information related to data side of the optical disc can again be determined (608), and the existing marking on the data side or the label side of the optical disc is determined (610). Determining the existing marking may include reading the data file of the marking that was previously saved, reading an indicia representing the marking that was previously written, or scanning in or reading the marking itself. . . .

The marking is then updated based on the information related to the data side of the optical disc as has been again determined (612).

(Anderson '586 at col. 7, lines 49-63 (emphasis added.)) It is clear from this portion of the reference that, rather than "detecting a difference," as required by claim 6, Anderson '586 instead simply determines again the "information related to data side of the optical disk."

Thus, Anderson '205 and Anderson '586, alone or in combination, fail to teach or suggest each and every element of independent claim 6. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 6 and its dependent claims 7, 9, 10, 12, 14 and 15.

Independent claim 16 recites features similar to those of independent claim 6. Claim 16, therefore, is also patentable at least for reasons analogous to those set forth above with respect to claim 6. Claim 16 also describes rewriting of the indication layer to provide a visible output. To the extent a phase contrast is rewritable, Applicant submits that phase contrast is not visibly perceived. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 16 and its dependent claims 17-19 and 21.

Anderson '205 in view of Anderson '586 and Nakano

Claims 8, 13 and 20 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Anderson '205 in view of Anderson '586 and further in view of U.S. Patent Publication No. 2001/0008872 to Nakano ("Nakano"). Applicant traverses this rejection for at least the following reasons.

Claims 8, 13 and 20 depend from independent claims 6 and 16. The deficiencies of Anderson '586 with respect to independent claims 6 and 16 have been demonstrated above. Nakano, moreover, fails to make up for the above described deficiencies, as Nakano is cited by the Examiner merely for its alleged teaching of an indication layer including electronic paper.

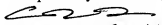
Thus, Anderson '205, Anderson '586, and Nakano, alone or in combination, fail to teach or suggest each and every element of claims 8, 13 and 20. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

This Application is being filed via the USPTO Electronic Filing System (EFS). Applicants herewith petition the Director of the USPTO to extend the time for reply to the above-identified Office Action for an appropriate length of time if necessary. Any fee due under 37 U.S.C. § 1.17(a) is being paid via the USPTO Electronic Filing System (EFS). The USPTO is also directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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